

## REMARKS

In accordance with the foregoing, claims 1, 5, 6, 13, 17, and 18 are amended. Claims 21-23 are added. No new matter is added. Claims 4 and 16 are cancelled. Claims 1, 5-13, and 17-23 are pending and under consideration.

### CLAIM OBJECTIONS

Claims 4 and 16 are cancelled herewith.

### CLAIM REJECTIONS UNDER 35 U.S.C. § 103

In the outstanding Office Action, claims 1, 4-13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,801,713 to Endo et al. (hereinafter "Endo") in view of U.S. Patent No. 6,002,798 to Palmer et al. ("Palmer").

Claim 1 is amended herewith to specify that a plurality of automatic paging display modes includes "a partially displaying mode in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition" besides the previously recited cursory reading display mode and outline display mode. The added feature is fully supported by the originally filed specification and claims, for example, the previously presented claim 4. Applicants respectfully submit that the cited prior art, Enzo and Palmer, alone or in combination, do not teach or suggest the display modes as recited in claim 1.

Additionally, the Office Action fails to provide a motivation for combining the teachings of the cited prior art references other than the synergetic result acquired by the present invention. The Office Action alleges that claim 1 (and 13) is (are) obvious by combining the automatic page turning of Enzo with the document displaying methods of Palmer, although neither Palmer nor Enzo include any suggestion for the combination.

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), cert. denied, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See *In re Rouffet*, 47 USPQ2d at 1457.

If identification of each claimed element in the prior art were

sufficient to negate patentability, the Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.

See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the Office action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

Many things may have been well known *individually* at the time of the invention. A rejection under 35 U.S.C. § 103(a) requires a showing that the *combination* of elements was obvious, that is, a showing that persons of ordinary skill in the art at the time the invention was made would have seen fit to form the claimed *combination*. Here, the Office Action has pointed to no teaching, either in the cited references or the general state of the art, as to why one of ordinary skill in the art at the time the invention was made would have been motivated to combine Enzo and Palmer's teachings.

Because the cited prior art fails to teach or suggest all the elements of claim 1 and no motivation for combining the prior art references is provided, Applicants respectfully submit that claim 1 and claims 5-12 depending from claim 1 are patentable.

Relative to claim 13, the prior art fails to teach or suggest at least "a partially displaying mode in which a portion of each page is displayed, the displayed portion being extracted according to a predetermined condition." Applicants respectfully submit that claim 13 and claims 17-20 depending from claim 13 are patentable at least due to the cited prior art's failure to teach or suggest all the elements of claim 13 and the lack of motivation for combining the teachings from the prior art references.

## NEW CLAIMS 21-23

New claim 21 is directed to a multi-page document displaying method comprising selecting a page-turning mode and selecting a display mode. New claim 21 is fully supported by the originally filed specification and claims, for example, FIGS. 3, 5, 11 and the corresponding descriptions. Claim 21 patentably distinguishes over the cited prior art at least by reciting that the combination of operations, selecting a page-turning mode and selecting a display mode, which is not taught or suggested in the prior art, and because the selected display mode may be "a partially displaying mode in which each page is displayed partially, by extracting and displaying a page portion according to a predetermined condition."

Claims 22- and 23 are also patentable by inheriting patentable features from claim 21 and by reciting additional patentable features.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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